

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

*Ex parte* TORE KOTLARSKI  
and TURE MARKLUND

Appeal No. 2002-2216  
Application 09/445,046

ON BRIEF

**MAILED**

**MAY 28 2003**

**PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Before PAK, WARREN and LIEBERMAN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

*Decision on Appeal*

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claim 14 and refusing to allow claims 5 through 12 as amended subsequent to the final rejection.<sup>1</sup> Claims 5, 9 and 14 are illustrative of the claims on appeal:

5. A wiper device for motor vehicles, comprising a driven wiper arm and a wiper blade connected to said wiper arm, said wiper arm moving said wiper blade back and forth across the window of a motor vehicle laterally to a longitudinal space of the window and loading said wiper blade in relation to the window, said wiper blade including an elongated wiper strip placeable against the window, and an elongated spring-elastic carrying element disposed on a side of said wiper strip remote from the window and having connecting means for connecting said wiper arm thereto, said spring-elastic carrying element extending parallel to an axis of elongation of said

<sup>1</sup> Appellants cancelled claim 13 subsequent to the final rejection.

wiper strip to distribute a contact force applied by said wiper strip under the action of said wiper arm against the window over an entire length of said wiper strip, said wiper strip having a center section and two end sections, said contact force of said wiper strip being greater in said center section than in at least one of said two end sections, said wiper strip having a wiper lip adapted to contact the window and is constructed such that it tilts over in reversal positions in wiping direction of said wiper blade in a region of a reduced contact force and continues to tilt in a region of a greater contact force against the window.

9. A wiper blade for a wiper device for a motor vehicle for wiping a window of the motor vehicle, comprising an elongated wiper strip placeable against the window, and an elongated spring-elastic carrying element disposed on a side of said wiper strip remote from the window, said spring-elastic carrying element extending parallel to an axis of elongation of said wiper strip to distribute a contact force against the window over an entire length of said wiper strip, said wiper strip having a center section and two end sections, such that a contact force of said wiper strip would be greater in said center section than in at least one of said two end sections.

14. A wiper blade for a wiper device for a motor vehicle for wiping a window of the motor vehicle, comprising an elongated wiper strip placeable against the window, and an elongated spring-elastic carrying element disposed on a side of said wiper strip remote from the window, said spring-elastic carrying element extending parallel to an axis of elongation of said wiper strip to distribute a contact force against the window over an entire length of said wiper strip, said spring elastic carrying element having a first side and a second side such that the wiper strip is placed at the first side, while at the second side which is opposite to the first side a connecting element is placed, said spring-elastic carrying element having a curvature which is sharper in a center section of said spring-elastic carrying element than in an end section thereof.

The appealed claims, as represented by claims 5, 9 and 14, are drawn to a wiper device for motor vehicles wherein the wiper blade comprises at least an elongated wiper strip connected to an elongated spring-elastic carrying element. The spring-elastic carrying element can have a curvature which is sharper in a center section of said spring-elastic carrying element than in an end section thereof, and distributes a contact force against the window over an entire length of said wiper strip such that a contact force of said wiper strip would be greater in said center section than in at least one of said two end sections. The wiper strip can have a wiper lip constructed such that it tilts over in reversal positions in wiping direction of said wiper blade in a region of a reduced contact force and continues to tilt in a region of a greater contact force against the window. According to appellants, the "tilting-over process . . . prevents the abrupt snapping over of the entire wiper lip and the unpleasant knocking noise connected with it" (specification, pages 2-3).

The references relied on by the examiner are:


Appel	4,028,770	Jun. 14, 1977
Arai et al. (Arai)	4,807,326	Feb. 28, 1989

The examiner has advanced the following grounds of rejection on appeal:

claims 5 through 7, 9 through 11 and 14 stand rejected under 35 U.S.C. § 102(b) as anticipated by Arai (answer, pages 5-6);

claims 9 through 12 and 14 stand rejected under 35 U.S.C. § 102(b) as anticipated by Appel as evidenced by Arai (answer, page 7);<sup>2</sup> and,

claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Arai in view of Appel (answer, pages 8-9).<sup>3</sup>

Appellants state in their brief (page 10) that the appealed “[c]laims 5, 9 and 14 are separately patentable” and that “the other claims . . . stand and fall together with the corresponding independent claims.” Thus, we decide this appeal based on appealed claims 5, 9 and 14. 37 CFR § 1.192(c)(7) (2002). 

We affirm the ground of rejection under § 102(b) over Arai and the ground of rejection under § 103(a) over Arai in view of Appel. We reverse the ground of rejection § 102(b) over Appel as evidenced by Arai.

Rather than reiterate the respective positions advanced by the examiner and appellants, we refer to the examiner’s answer and to appellants’ brief<sup>4</sup> for a complete exposition thereof.

#### *Opinion*

It is well settled that in making out a *prima facie* case of anticipation, each and every element of the claimed invention, arranged as required by the claim, must be found in a single prior art reference, either expressly or under the principles of inherency. *See generally, In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677-78, 7 USPQ 1315, 1317 (Fed. Cir. 1988); *Lindemann*

<sup>2</sup> Appellants incorrectly stated this ground of rejection as being under 35 U.S.C. § 103 (brief, page 10) as noted by the examiner (answer, page 3). We observe that the ground of rejection as stated by the examiner (answer, pages 3 and 7) was of record as of the final rejection in the Office action of July 27, 2001 (Paper No. 13; page 4), and thus appellants were on notice thereof.

<sup>3</sup> The examiner withdrew the ground of rejection under 35 U.S.C. § 112, second paragraph (answer, page 3).

<sup>4</sup> We have considered the brief filed February 28, 2002 (Paper No. 21).

*Maschinenfabrik GMBH v. American Hoist and Derrick*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). Whether the teachings and inferences that one skilled in this art would have found in the disclosure of an applied reference would have placed this person in possession of the claimed invention, taking into account this person's own knowledge of the particular art, is a question of fact. *See generally, In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995), and cases cited therein (a reference anticipates the claimed method if the step that is not disclosed therein "is within the knowledge of the skilled artisan."); *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968) ("[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one of ordinary skill in the art would reasonably be expected to draw therefrom.").

The examiner submits, and we agree, that as a matter of fact, *prima facie*, the wiper device and wiper blade taught by Arai anticipate the claimed wiper device encompassed by appealed claim 5 and the claimed wiper blade encompassed by appealed claim 9 and appealed claim 14, because each and every element arranged as required for the claimed articles encompassed by each of these appealed claims is shown in Arai either expressly or under the principles of inherency. The critical element of the claimed articles is the carrying element which has the curvature with respect to the center section and the ends thereof specified in appealed claim 14; distributes a contact force over the entire length of the contact strip in appealed claims 5 and 9, wherein the contact force is greater in a center section of the carrying element than at either or both of the two ends thereof in appealed claim 5; and because of the difference in contact force, causes the wiper lip to tilt over in reversal positions in wiping direction of the wiper blade beginning in the region of reduced contact force, that is, at the ends of the carrying element, and continuing to the region of greater contact force, that is, at a center section of the carrying element, in appealed claim 5.

The examiner's observation that the curvature of the "backing member" shown in the Arai FIGs., which is the carrying element of the Arai articles and which we herein refer to as the carrying element of Arai, is identical to the requirement for the carrying element in appealed claim 14 is borne out by the disclosure in the reference that with respect to FIG. 5, "[t]he

curvature is gradually decreased at longitudinally opposite end portions 3A and 3A” (col. 3, lines 29-30). We find that one skilled in the art would reasonably interpret this disclosure to describe a center section which has a greater curvature than either of the end portions 3A. Indeed, the plain language of appealed claim 14 merely specifies “a center section” of the carrying element, which can be any section in the center of the carrying element as the examiner points out, particularly in view of the indefinite article “a,” and the claim phrase “an end section” includes either of the two end sections of the carrying element.

While Arai is interested in applying a uniform pressure along the length of the wiper blade with the carrying element disclosed therein (col. 3, lines 30-36), we agree with the examiner that the high pressure distribution curve showing the pressure applied on the wiper blade by the article of Arai in FIG. 7<sup>5</sup> (see col. 3, lines 48-51) demonstrates that, at that pressure, the contact force of the wiper strip is greater in the center section than at both of the end sections (see also col. 4, lines 1-8), as required by appealed claims 5 and 9.

On this record, in view of the congruent structure between the carrying elements of the claimed wiper device and wiper blades encompassed by appealed claim 5 with the corresponding articles disclosed by Arai, we further agree with the examiner that the wiper blade of Arai would inherently react in the same manner to the distribution of contact force at high pressure as required by appealed claim 5, that is, the wiper blade tip would tilt over in reversal positions beginning at the wiper blade tip regions and continuing to the center region of the wiper blade, even though Arai is silent in this respect. Indeed, while we have focused on the correspondence in carrying elements, we further observe no difference between the wiper blade tip in Arai FIGs. 2 and 4 and the wiper blade tip in specification FIGs. 3 and 4. Thus, on the basis of this substantial evidence, we are of the opinion that, *prima facie*, the wiper article and wiper blade of Arai would *necessarily* inherently function in the manner required of the claimed wiper article and wiper blade of appealed claim 5. See *Transclean Corp. v. Bridgewood Services, Inc.*,

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<sup>5</sup> We cannot agree with the examiner’s findings with respect to FIG. 8 of Arai because the pressure distribution curves are merely disclosed to “shows prior art wiperblade” for which the reference provides no disclosure of the structure of the prior art article (col. 2, lines 30-31, and col. 3, lines 52-53). Thus, there is no factual basis for comparing the results reported in Arai FIG. 8 with the articles claimed in the appealed claims.

290 F.3d 1364, 1372-73, 62 USPQ2d 1865, 1870-71 (Fed. Cir. 2002), citing *Cont'l Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268-69, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991)

("[A]nticipation by inherent disclosure is appropriate only when the reference discloses prior art that must *necessarily* include the unstated limitation.").

Accordingly, in view of the *prima facie* case of anticipation over Arai established by the examiner, the burden has shifted to appellants to present effective argument and/or objective evidence to patentably distinguish the claimed articles encompassed by appealed claims 5, 9 and 14 from the corresponding articles of Arai. In this respect, we again considered all of the evidence of anticipation found in the applied prior art with appellants' countervailing evidence of and argument for non-anticipation set forth in the brief. *In re Spada*, 911 F.2d 705, 707 n.3, 15 USPQ2d 1655, 1657 n.3. (Fed. Cir. 1990).

Appellants merely contend with respect to appealed claim 5, that Arai does not disclose a wiper device that provides the tilting action in reversal position that is required in the appealed claim. However, upon reconsidering the evidence in Arai, we remain of the view that there is sufficient correspondence between the claimed and reference wiper devices, particularly the carrying elements and the wiper blades, to constitute substantial evidence that such tilting action, described by the examiner as conventional in such devices, would necessarily inherently occur in the identical devices in the absence of effective argument or objective evidence to the contrary patentably distinguishing the claimed article submitted by appellants. We find that appellants' mere observation of silence in the reference with respect to tilting action of the wiper tip does not constitute such argument or evidence. *See generally, In re Best*, 562 F.2d 1252, 1254-56, 195 USPQ 430, 432-34 (CCPA 1977); *In re Skoner*, 517 F.2d 947, 950, 186 USPQ 80, 83 (CCPA 1975). Indeed, appellants' elucidation of the mechanism of the function of an article does not render the old article again patentable simply because those using the article may not have appreciated the mechanism thereof or the results produced thereby. *Compare, e.g., W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983) ("[I]t is . . . irrelevant that those using the invention may not have appreciated the results. . . . Were that alone enough to prevent anticipation, it would be possible to obtain a patent for an old and unchanged process. [Citations omitted.]").

Appellants' argument with respect to areas of different contact force applied by the carrying element as required by appealed claim 9 does not dispute the evidence in Arai **FIG. 7** with respect to the high pressure curve as relied on by the examiner and thus, in the absence of a factual basis, is entitled to little, if any, weight. *See generally, In re Lindner*, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972) ("This court has said . . . that mere lawyers' arguments unsupported by factual evidence are insufficient to establish unexpected results. [Citations omitted.]"). Appellants' argument with respect to the curvature requirement in appealed claim 14 is based on their perception vs. the examiner's perception of the carrying element shown in Arai **FIGs. 5 and 6** in this respect. As we pointed out above, the disclosure at col. 3, lines 29-30, supports the examiner's perception.

Accordingly, based on our consideration of the totality of the record before us, we have weighed the evidence of anticipation found in Arai with appellants' countervailing evidence of and argument for no anticipation in fact and find that the claimed invention encompassed by appealed claims 5 through 7, 9 through 11 and 14 are anticipated as a matter of fact under 35 U.S.C. § 102(b).

We cannot reach the same determination with respect to the ground of rejection of appealed claims 9 and 14 under § 102(b) as anticipated by Appel as evidenced by Arai because we find that the examiner has not made out a *prima facie* case of anticipation over the combination of references. While it is entirely appropriate to rely on another reference to clarify a fact in the anticipating reference, *see generally, In re Samour*, 571 F.2d 559, 562, 197 USPQ 1, 4 (CCPA 1978), the supporting reference must in fact accomplish that purpose. In this instance, the examiner relies on Arai **FIG. 8** to establish that "the contact pressure in the center of the blade would be greater than ends sections thereof" when using the wiper blade with the carrying element shown in Appel and disclosed therein to provide uniform pressure along the blade as the examiner acknowledges. We have the same difficulty here with Arai **FIG. 8** as we did before, that is, there is no disclosure of the structure of the "prior art wiperblade" represented in that figure (*see above note 4*). Accordingly, we reverse the ground of rejection of appealed claims 9 through 12 and 14 under § 102(b) as anticipated by Appel as evidenced by Arai.

Finally, we consider the ground of rejection of appealed claim 8 under 3(a) over Arai in view of Appel. As the examiner points out (answer, page 3), appellants have not disputed this ground of rejection in the brief even though they acknowledge its existence (brief, page 10),<sup>6</sup> stating instead that dependent claims “stand and fall together with the corresponding independent claims” (*id.*). Because we have affirmed the ground of rejection of appealed claim 1<sup>5</sup> on which appealed claim 8 depends, under § 102(b) over Arai, which reference is relied on as the primary reference in the ground of rejection here, we summarily affirm this ground of rejection.

The examiner’s decision is affirmed with respect to appealed claims 5 through 11 and 14 and reversed with respect to appealed claim 12.<sup>7</sup>

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<sup>6</sup> See also the final rejection in the Office action of July 27, 2001 (Paper No. 13; pages 5-6).

<sup>7</sup> We point out that we reverse the sole ground of rejection applying to appealed claim 12 and it is with respect to this ground of rejection that appealed claim 12 stands or falls with appealed claim 9 on which it is dependent. See 37 CFR § 1.192(c)(7) (2002).



No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

***AFFIRMED-IN-PART***

  
CHUNG K. PAK

Administrative Patent Judge

  
CHARLES F. WARREN

CHARLES F. WARREN  
Administrative Patent Judge

  
PAUL LIEBERMAN

PAUL LIEBERMAN  
Administrative Patent Judge

BOARD OF PATENT  
APPEALS AND  
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Appeal No. 2002-2216  
Application 09/445,046

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